

REMARKS¹

In the outstanding Office Action, the Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,424,245 to Gurtler et al. (“Gurtler”) in view of U.S. Patent No. 5,977,640 to Bertin et al. (“Bertin”), and U.S. Patent No. 6,384,485 to Matsushima (“Matsushima”). By this amendment, Applicant proposes amending claim 25. Claims 1, 2, 4-11, 14-18 and 25 are pending in this application, with claim 25 presented for examination.

Applicant respectfully traverses the rejection of claim 25 under 35 U.S.C. § 103(a).

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must “be found in the prior art, and not be based on applicant’s disclosure.” See MPEP § 2143, 8th Ed. (Rev. 5), August, 2006. At a minimum, the Examiner cannot establish a *prima facie* case of obviousness because the references,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

whether taken alone or in combination, fail to teach or suggest each and every element recited in claim 25.

For example, claim 25, as amended, recites a combination including “an interlayer insulation film and a surface protection film coated on the semiconductor element formation surface side.” Gurtler fails to teach or suggest at least this element.

Gurtler teaches “two-sided composite chip 21 comprises semiconductor substrate 26 having IC device layer 24, interconnect layer 22 and inter-chip interconnects 20 on the first surface of semiconductor substrate 26.” Gurtler, col. 2, lines 50-53. Gurtler, however, is silent as to at least a surface protection film, and thus fails to teach or suggest a combination including “an interlayer insulation film and a surface protection film coated on the semiconductor element formation surface side,” as recited in amended claim 25.

Bertin fails to cure the deficiencies of Gurtler. Bertin teaches “a conformal coating 34 (e.g., paralene) is deposited over the entire surface ... then planarized ... to mechanically polish the surface.” However, Bertin does not teach that conformal coating is “a surface protection film,” as recited in claim 25. Moreover, Bertin is silent as to an interlayer insulation layer. Accordingly, Bertin fails to teach or suggest a combination including “an interlayer insulation film and a surface protection film coated on the semiconductor element formation surface side,” as recited in amended claim 25.

Matsushima fails to cure the above-noted deficiencies of Gurtler and Bertin. Matsushima teaches “[w]ithin the upper multi-layer portion and the lower multi-layer portion, a signal layer 9, a power-supply layer plane layer 10, and a ground plane layer

11 are inserted in a certain order at substantially even intervals." Matsushima, col. 1, lines 54-57. Matsushima, however, is silent as to at least "an interlayer insulation film," and a "surface protection film," as recited in amended claim 25. Accordingly, Matsushima fails to teach or suggest a combination including "an interlayer insulation film and a surface protection film coated on the semiconductor element formation surface side," as recited in amended claim 25.

For at least the reason that the references fail to teach or suggest every element recited in claim 25, a *prima facie* case of obviousness cannot be established. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 25 under 35 U.S.C. § 103(a).

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claim 25 in condition for allowance. Applicant submits that the proposed amendment of claim 25 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claim as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 3, 2007

By: 
Darrell D. Kinder, Jr.
Reg. No. 57,460